

REMARKS

Upon entry of this amendment, independent claim 1 with dependent claims 3-8 will be present in the application.

Claim 1 has been amended to recite that the screen rods have an embedded end, which had previously been recited in claim 2. Claim 1 has also been amended to eliminate the recitations that the first side wall faced the flow of pulp suspension and the second side wall faced away from the flow of pulp suspension, to overcome the rejection of the specification under 35 U.S.C. § 112, first paragraph. Claim 1 has further been amended to recite that all portions of each protrusion being positioned at a distance from the embedded end of the rod. Such structure is shown in Figure 1 of the application. New claim 11 is directed to a cylindrical screen basket comprising the rod-bearing supporting element and rods recited in claim 1. In addition claim 11 recites that the rod-bearing supporting element is rolled to define a substantially circular shape, whereby the rod-bearing supporting element and the rods form a substantially cylindrical screen basket. Such structure had previously been recited in claim 7, which has been canceled. The Applicant respectfully submits that none of the claim amendments introduce new matter.

The drawings were objected to under 37 CFR 1.83(a). The claims and specification have been amended to delete reference to sidewalls facing towards or away from the flow of pulp suspension. Figure 1 has been amended such that the left-hand sidewall has only one protrusion and to include line II-II. New Figure 3 has been added, showing a cylindrical screen basket formed from the screen of Figure 1. Since such structures are described in the specification and recited in the claims, amending Figure 1 and adding Figure 3 does not introduce new matter.

The specification has been amended to recite that United States Patent Application Serial Number 09/776,320 has now been abandoned, as requested by the Office Action. The specification has also been amended to correct the typographic errors noted in the Office Action.

Claims 1-10 were rejected under 35 U.S.C. § 112, first paragraph. As noted above, the claims and specification have been amended to delete reference to sidewalls facing towards or away from the flow of pulp suspension. The specification has also been amended to recite that the *indentations* provided in the supporting element 2 to hold the rod 1 can have clearance equivalent to the angle α .

Claims 1-10 were rejected under 35 U.S.C. § 112, second paragraph, the Office Action alleging that the preamble of claim 1 is misdescriptive. The Office Action also alleges that with respect to claim 7, it is unclear how the screen mat can be cylindrical when it has been previously defined as being planar in claim 1. The Applicant respectfully submits that a person of ordinary skill in the art would not find claim 1 to be misdescriptive or claim 7 to be unclear. Specifically, the Lange reference cited in the Office Action discloses a similar type of screen that is manufactured as a planar screen that may be bent to form a cylindrical screen. As defined in claim 1, the invention is a planar screen where

the inner surface of the receptacle defines a clearance angle α having a value greater than zero with the second sidewall of the rod. Claim 7 has been rewritten in independent form as claim 11, which recites a cylindrical screen basket formed of rod-bearing supporting element and rods of claim 1, where the rod-bearing supporting element has been rolled to define a circular shape whereby the rods mounted to the rod-bearing supporting element form a cylindrical screen basket. Claim 11 does not include any recitation of a clearance angle between the inner surface of the receptacles and the sidewall of the rods.

Claims 1-10 were rejected under 35 U.S.C. § 103(a) as being obvious over U.S. 5,768,783 (Lange), the Office Action alleging that the sidewalls of the bars 3 define a protrusion "e.g., the curved surface portion". Claims 1 and 11 recite "all portions of each protrusion being positioned at a distance from the embedded end of the rod". The portion of the Lange bars that are alleged to be equivalent to the protrusion of the subject rod is the entire embedded end of the bar. Accordingly, none of the references cited by the Office Action disclose a filter having a rod with sidewall protrusions, where all portions of each protrusion is positioned at a distance from the embedded end of the rod. MPEP § 706.02(j) states "[t]o establish a *prima facie* case of obviousness, three basic criteria must be met. ... the prior art reference (or references when combined) must teach or suggest all the claim limitations." See also MPEP §§ 2142 and 2143. Since the prior art references cited in the Office Action do not teach or suggest all of the claim limitations, the rejection must be withdrawn.


The Office Action admits that Lange fails to specify the protrusion as having a circular shape having a radius r of 0.1 mm to 2 mm but alleges that "such modification would have been obvious in order to optimize the strength of the connection between the rods 2 and rod-bearing supporting element." However, such allegation is purely conjecture. There is nothing in the prior art or in the Office Action that teaches or suggests that the shape of the "protrusion" that is alleged to be disclosed by Lange does not provide the optimum strength connection with the support element 2a. Further, the Office Action does not show how modifying the shape of the Lange "protrusion" to have the shape and size recited in claim 1 will in fact provide a better connection with the support element 2a.

The Federal Circuit has held that the prior art must provide some teaching, suggestion, or incentive to make the combination made by the inventor. The Board of Patent Appeals and Interferences has held that "deeming [a combination obvious] does not discharge him [the examiner] from the burden of providing the requisite factual basis and establishing the requisite motivation to support a conclusion of obviousness." Ex parte Stern, 13 USPQ2d 1379, 1381 (B. Pat. App. & Int. 1989). The Office Action has not shown where the prior art provides an incentive to make the combination of the subject application, nor has the Office Action provided an analysis proving that a circular protrusion having radius r of $0.1 \text{ mm} < r < 2 \text{ mm}$ will provide a better connection with the support element 2a than the "protrusion" taught by Lange. Consequently, the Applicant respectfully submits that the Office Action does not provide the requisite factual basis or motivation necessary to sustain the rejection under 35 U.S.C. § 103.

Without showing how the prior art teaches or suggests the circular protrusion of claim 1, or without proving that the circular protrusion of claim 1 will provide a better connection than the unmodified Lange "protrusion", it is clear that the Office Action impermissibly utilizes the disclosure of the subject application to arrive at the conclusion that it would have been obvious to modify the Lange "protrusion".

In view of the above-directed amendments and the proceeding remarks, prompt and favorable reconsideration is respectfully requested.

Respectfully submitted,
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Amendments to the Drawings:

The attached sheets of drawings include changes to Figure 1 and new Figure 3.

The first sheet, which includes Figures 1 and 2, replaces the original sheet including Figures 1 and 2. The second sheet includes new Figure 3.

Appendix A: Replacement Sheets

APPENDIX A